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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/645,606 | 08/22/2003 | Ralf Meycr | P23941 | 9475 |
| 7055 | 7590 | 02/07/2006 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | MAYES, DIONNE WALLS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1731 | |
| DATE MAILED: 02/07/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/645,606 | Applicant(s) MEYER ET AL. | |
| | Examiner Dionne Walls Mayes | Art Unit 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 15-20 and 31-34 in the reply filed on December 21, 2005 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that a concurrent examination of these groups, and each species, would present a "serious burden", especially in light of the "substantial degree of overlap" any search of the two inventions would entail. This is not found persuasive because the Examiner believes that "an appropriate explanation" was advanced by the Examiner as to the "serious burden" that would be placed on her should the Inventions be examined together. (Please see the Written Restriction, in its entirety). Further, Applicant has failed to rebut the prima facie showing of a serious burden because Applicant has failed to provide an appropriate showing or evidence to rebut the prima facie showing of serious burden which WAS set forth in the restriction requirement - as is required by MPEP 803. Merely arguing that because the search areas required to examine both inventions will substantially overlap does not meet the requirement of MPEP 803 to rebut a prima facie showing of serious burden.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 15-20 and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/39880.

WO 96/39880 discloses all that is recited in the claims since it teaches a device for manufacturing cigarettes which includes an apparatus for assembling groups of filter segments comprising two units, tubular filter rod maker 196 and mouthpiece filter rod maker 198, structured and arranged to provide at least two different type of filter segments; combiner 194 (corresponding to the claimed "first assembling device"); grading drum 226 (corresponding to the claimed "separation device/staggered drum"), wherein one filter-rod part is positioned forward but offset from the other; and alignment drum 246 (corresponding to the claimed "sliding drum"), wherein one filter-rod part is positioned forward parallel to and inline from the other. Therefore, the WO 96/39880 reference anticipates the claims.

4. Claims 15-20 and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 267 021.

GB 2 267 021 discloses all that is recited in the claims since it teaches a device for manufacturing cigarettes which includes an apparatus for assembling groups of filter segments comprising two units, a dispenser of black filter sections and a dispenser of white filter sections (corresponding to the claimed "two units structured and arranged to provide at least two different types of filter segments"); a drum 34 which arranges the filter sections in axial alignment (corresponding to the claimed "first assembling device"); drum 38 with rolling plate 40 (corresponding to the claimed "separation device/staggered drum"), wherein the filter sections are offset from each other; and

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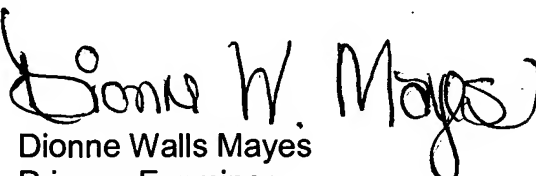
alignment drum 42 (corresponding to the claimed "sliding drum"), wherein the filter parts are ploughed back together in axial alignment. Therefore, the GB 2 267 021 reference anticipates the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dionne Walls Mayes
Primary Examiner
Art Unit 1731

February 3, 2006